



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/568,154	02/13/2006	Mitsuo Kimura	JFE-06-1012	5904

35811 7590 01/14/2010
IP GROUP OF DLA PIPER LLP (US)
ONE LIBERTY PLACE
1650 MARKET ST, SUITE 4900
PHILADELPHIA, PA 19103

EXAMINER

FOGARTY, CAITLIN ANNE

ART UNIT	PAPER NUMBER
----------	--------------

1793

NOTIFICATION DATE	DELIVERY MODE
-------------------	---------------

01/14/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

pto.phil@dlapiper.com

Advisory Action Before the Filing of an Appeal Brief	Application No. 10/568,154	Applicant(s) KIMURA ET AL.	
	Examiner CAITLIN FOGARTY	Art Unit 1793	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 17 December 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
 b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ They raise the issue of new matter (see NOTE below);
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
 5. ☐ Applicant's reply has overcome the following rejection(s): _____.
 6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
 The status of the claim(s) is (or will be) as follows:
 Claim(s) allowed: _____.
 Claim(s) objected to: _____.
 Claim(s) rejected: 24-34.
 Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
 12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____.
 13. ☐ Other: _____.

/Roy King/
 Supervisory Patent Examiner, Art Unit 1793

/Caitlin Fogarty/
 Examiner, Art Unit 1793

Continuation of 11. does NOT place the application in condition for allowance because: the amendment to claim 24 did not change the scope of the claims and Applicant's arguments are not persuasive. Therefore, the rejections set forth in the 8/11/2009 Office action have been maintained.

Applicant argued that the inventive steel is sharply different from the JP '009 steels because the JP '009 steels have a different objective. JP '009 seeks to maximize the strength of the martensitic stainless steel and seeks to provide a dual-phase steel with a maximum amount of martensite and a minimal amount of retained austenite. The Applicants proceeded in a completely different direction and do not seek to have steels with such a high volume fraction of martensite. Instead, Applicants seek a steel that has a balance of austenite, ferrite and martensite. As a consequence, the Applicants' maximum amount of martensite, based on the austenite and ferrite phase limitations, is 87.4%. This is sharply contrasted to the steels of JP '009 which have far, far higher quantities of martensite ranging from 90.3-98.6% which is in accordance with the objective of JP '009. JP '009 intends to maximize the amount of martensite, while the Applicants' objective is to reduce the amount of martensite so that there is an ample amount of austenite and ferrite present to achieve the goals of having superior corrosion resistance, yield strength and the like.

The Examiner's response is that JP '009 is not required to teach the same objectives as the prior art. See MPEP 2144 IV. The Examiner maintains the position that JP '009 is not limited to the specific embodiments it teaches (see MPEP 2123). Furthermore, in the absence of factual evidence to the contrary, the Examiner maintains the position that since the composition and microstructure of austenite and martensite of the stainless steel pipe of JP '009 is similar to the composition and microstructure of austenite and martensite of the instant invention and since the pipe is made using a similar method, one of ordinary skill in the art would expect the stainless steel seamless pipe of JP '009 to have a similar volume fraction of ferrite phase. Applicant has not provided evidence to show that the stainless seamless steel pipe of JP '009 is materially different from the pipe of the instant invention. Furthermore, the maximum amount of martensite of 87.4% martensite recited in the instant invention is very close to the amount of martensite in the specific embodiments of JP '009 of such as 90.3% martensite.

Applicant also argued that they have supplied facts on the record that demonstrate material differences between the stainless steels of JP '009 and the Applicants' stainless steels. When equation (2) in Applicants' claim 24 and equation (1) in claim 1 of JP '009 are compared, although there are some differences in their coefficients, they are almost the same. The values calculated by equation (2) in claim 24 inevitably are lower than the values calculated by equation (1) in claim 1 of JP '009. JP '009 employs component equation (1) for the purpose of securing high strength and toughness. To prevent generation of ferrite according to equation (1) in JP '009, the maximum value is limited to 10 in equation (1). However, claim 24 recites an equation which is similar to equation (1) of JP '009 and the minimum value 11.5 is specified so that ferrite of a fixed amount becomes precipitated. This is an opposite approach from the approach of JP '009.

The Examiner's response is that the Applicants' arguments concerning equation (2) of the instant application and equation (1) of JP '009 are considered Applicants' arguments rather than factual evidence since they are not in declaration form. In addition, Applicant has not demonstrated the criticality of claimed equation (2) in instant claim 24. Therefore, in the absence of factual evidence to the contrary, the Examiner maintains the position that it is well settled that there is no invention in the discovery of a general formula if it covers a composition described in the prior art. In the absence of evidence to the contrary, the selection of the proportions of elements would appear to require no more than routine investigation by those ordinary skilled in the art.